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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/580,743	05/26/00	GEORGE	L 2870/289

EXAMINER	
LOVERING, R	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Offic Acti n Summary	Application No. 09/580,743	Applicant(s) GEORGE ET AL.
	Examiner LOVERING	Group Art Unit 1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on SEPT. 20, 2000 AND MAR. 6, 2001.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-43 is/are pending in the application.

Of the above claim(s)____ is/are withdrawn from consideration.

☐ Claim(s)____ is/are allowed.

☒ Claim(s) 1-16 AND 19-43 is/are rejected.

☒ Claim(s) 17 AND 18 is/are objected to.

☐ Claim(s)____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☒ Notice of Reference(s) Cited, PTO-892

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other____

Office Action Summary

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 4-6, 31 and 43 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Franco et al. 5,994,414. The instantly-claimed water thin oil-in-water emulsions and method of making them are anticipated by Franco et al. (esp. abstract; and col. 1, line 66; col. 4, line 21, particularly col. 2, lines 29-52), or are at least clearly within the preview of Franco et al., and thus would have been obvious therefrom to one having ordinary skill in the art at the time applicants' invention was made. Addressing the 103 aspects of this ground of rejection: as to claim 4 herein, it would have been obvious to one skilled in the art at the time applicants' invention was made to omit the ethoxylated emulsifiers from the lotion formulation in col. 2 of Franco et al. since it is evident from col. 2, lines 15-28

and patent claim 1 that ethoxylated emulsifiers are not essential; and as to 6 herein, it would have been obvious to one skilled in the art at the time applicants' invention was made to lower the concentration of glycerol monoester to 0.5 wgt. % in view of patentees' suggestion in the sentence bridging col's. 4 and 5.

4. Claims 2, 3, 7, 8, 10-12, 19-30, 32, 33 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franco et al in view of W091/01970 hereinafter "Holmes" or George et al; "Versatile and Efficient Emulsification Technology Based on a Nonconventional Anionic Rheology Modifier". The especially pertinent portions of Franco et al. are pointed out in the preceding paragraph. While Franco et al. may not specifically disclose emulsions in which the emulsifier is one or more 2 - amidocarbonyl-benzoic acid compounds, it would have obvious to one skilled in the art at the time applicants' invention was made to apply the homogenizing process of Franco et al. to emulsions containing such emulsifier(s) of Holmes or George et al. to obtain stable, water-thin emulsions having the advantage(s) taught by Franco et al. (col. 4, lines 9-22). As to claims 10-12 and 30, it would further have been obvious to one skilled in the art at the time applicants' invention was made to include in the resulting emulsions a gum (presumably a polysaccharide) to adjust viscosity in view of the suggestion of Holmes (page 104).

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Franco et al. in view of Carrera et al. 5,264,363. The especially pertinent portions of Franco et al. are pointed out in paragraph 3 above. While Franco et al. may not specifically disclose emulsions in which the emulsifier is surfactant, it would have been obvious to one skilled in the art at the time

applicants' invention was made to apply the homogenizing process of Franco et al. to emulsions containing the surfactant of Carrera et al. to obtain stable, water-thin emulsions having the advantage(s) taught by Franco et al. (col. 4, lines 9-22).

6. Claims 13, 14, 31-33 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franco et al. in view of Nagahama et al. 6,140,375. The especially pertinent portions of Franco et al. are pointed out in paragraph 3 above. While Franco et al. may not disclose emulsions in which the emulsifier(s) is/are glycerol myristates or stearates and/or sucrose stearate, it would have been obvious to one skilled in the art at the time applicants' invention was made to apply the homogenizing process of Franco et al. to emulsions containing the above-stated surfactant(s) of Nagahama et al. to obtain stable, water-thin emulsions having the advantages taught by Franco et al. (col. 4, lines 9-22).

7. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franco et al. in view of Nagahama et al. as applied to claims 13, 14, 31-33 and 38 above, and further in view of Gabby et al. 3,936,391.

While the foregoing combination of Franco et al. and Nagahama et al. does not disclose incorporating a polymer such as xanthan gum into their emulsions, it would have been obvious to one skilled in the art at the time applicants' invention was made to post-add the xanthan gum of Gabby et al. (Examples B-E) to emulsions of the above-stated combination to function as a stabilizer in view of the teachings of Gabby et al. (col. 2, line 46 - col. 3, line 5).

8. Claims 34, 35, 39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franco et al. in view of Thill 5,178,871. The especially pertinent portions of Franco et al. are pointed out in paragraph 3 above. While Franco et al. do not disclose making a multiple emulsion from their oil-in-water emulsions by combining a water-in-oil emulsion therewith, it would have been obvious to one skilled in the art at the time applicants' invention was made to do so in view of the disclosure of Thill (col. 2, lines 37-44) when the ultimate intended use make a dual emulsion necessary or desirable. See Thill (col. 2, line 4 - col. 3, line 8).

9. Claims 36, 37, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franco et al. in view of Holmes or George et al. as applied to claims 2, 3, 7, 8, 10-12, 19-30, 32, 33 and 38 above, and further in view of Thill 5,178,871. While the combinations of Franco et al. with Holmes or George et al. do not disclose making a multiple emulsion from their oil-in-water emulsions by combining a water-in-oil emulsion therewith, it would have been obvious to one skilled in the art at the time applicants' invention was made to do so in view of the disclosure of Thill (col. 2, lines 37-44) when the ultimate intended use makes a dual emulsion necessary or desirable. See Thill (col. 2, line 4 - col. 3, line 8).

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 7 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 7 is indefinite and inaccurate in "derivatives thereof (for example, basic amino acids)". The quoted expression is indefinite since the metes and bounds thereof are not clear. Also, basic amino acids are not derivatives" of the stated cations M+.

Claim 12 recites a Markush group which is not considered proper for the reasons that it is indefinite as to scope and incomplete as to its membership in reciting "or"instead of--and--at line 2.

12. Claims 17 and 18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or fairly suggest the water-thin emulsion having all the ingredients of claims 17 and 18.

14. The disclosure is objected to because of the following informalities: In the specification page 2, ninth line from the bottom, "Figures" should be ---Drawings --.

Appropriate correction is required.

15. In view of the papers filed March 6, 2001, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CAR 1.48(c). The inventorship of this application has been changed by addition of Michelle Matathia and Charles Craig Tadlock.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

16. The remaining references listed on the attached form PTO-1449 and form PTO-892 are cumulative to the references applied herein, and/or further show the state of the art.

17. Any inquiry concerning this communication should be directed to Examiner Lovering at telephone number (703) 308-0443.

Lovering/dh

July 27, 2001

Richard D. Lovering

RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP 1200/1700